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09/810,159	03/19/2001	Shuwu Wu	10587.0298-00000	9046
22852	7590	12/07/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER NAWAZ, ASAD M	
			ART UNIT 2455	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/810,159

**Applicant(s)**

WU ET AL.

**Examiner**

ASAD M. NAWAZ

**Art Unit**

2455

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-15 and 21-44 is/are rejected.
- 7) ☒ Claim(s) 9 and 16-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 10/11/2010.

**DETAILED ACTION**

1. This action is responsive to the RCE filed 10/11/10. Claims 1-44 were resubmitted for consideration. An IDS was submitted with the RCE and has been considered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 10-15, 21-25, 37-39, and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barsness (US PG PUB 2008/0082620 A1) in view of Isaacs et al (US Patent No 7,043,530) hereinafter referred to as Issacs further in view of Salesky et al (US Publication No 2010/0306674) hereinafter referred to as Salesky.

As to claim 1, Barsness teaches a communications method comprising:

establishing a text instant messaging communication session between a sender and a recipient through an instant messaging host (0007, 0050, an instant messaging session is established via an instant message server);

facilitating a text instant message to be sent from the sender to the recipient during the session, the text instant message including message text inputted by the sender (0050, an instant message sent by a user is retrieved by the instant messaging server and displayed on the recipient's screen);

enabling presentation of a first text instant messaging graphical user interface to the recipient that includes the display of the message text, the presentation of the text instant message graphical user interface being conditioned on communication of the text instant message between the sender and the recipient (0050, the recipient is alerted to an incoming instant message by a pop-up window displaying the message)

However, Barness does not explicitly indicate that the graphical user interface includes an icon such that by enabling manipulation by the recipient of the icon, voice communication is invoked between the sender and the recipient through the instant messaging host.

Issacs teaches a system in which text instant messages and sound instant messages are exchanged between users (col 4, lines 14-17). Issacs further teaches enabling manipulation by the recipient of an icon to invoke voice communication between the sender and the recipient through the instant messaging host (col 6, lines 15-21 and col 7, lines 44-67, users may communicate with one another by sending voice instant messages. For example, a user may want to terminate a session with Bonnie and sends here a voice instant message saying "BYE" by selecting the "BYE" icon).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to make the system more efficient and enhance user experience. By using dedicated icons to send simple messages, users can quickly contact each other and make arrangements in a personal manner (col 9, lines 47-56). By utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51).

However Barness-Issacs do not teach that it is based on voice communication capabilities of the recipient. Salesky teaches a conferencing system in which various parameters are monitored and the system is reconfigured dynamically and automatically taking advantage of the software and hardware capabilities of the conferees/participants, including but not limited to voice communication capabilities (abstract, 0097, 0122).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Salesky into those of Barness-Issacs to make the system more robust. By allowing the system to dynamically adjust to the user's capabilities, presence awareness and user responsiveness is greatly improved and efficient communication is facilitated.

As to claim 2, Barness teaches the method of claim 1 further comprising receiving and authenticating the text instant message from the sender at the instant messaging host (0033, 0036).

As to claim 3, Barness teaches the method of claim 2 wherein authenticating the text instant message comprises identifying a screen name associated with at least one of the sender and the recipient (0035).

As to claim 4, Barness teaches the method of claim 2, wherein authenticating the text instant message comprises identifying an IP address associated with at least one of the sender and the recipient (0029, 0035)

As to claim 5, Salesky teaches the method of claim 1 further comprising determining voice communication capabilities of the recipient at the instant messaging host (abstract, 0097, 0122).

As to claim 6, Salesky teaches the method of claim 5 wherein determining voice communication capabilities comprises identifying hardware associated with the recipient (abstract, 0097, 0122).

As to claim 7, Salesky teaches the method of claim 5 wherein determining voice communication capabilities comprises identifying software associated with the recipient (abstract, 0097, 0122).

As to claim 8, Salesky teaches the method of claim 5 further comprising reporting the voice communication capabilities of the recipient to the sender (0097, 0122).

As to claim 10, Barness teaches the method of claim 1, further comprising receiving at the instant messaging host, a request to establish communication (0042, 0050). However, Barness does not explicitly indicate establishing a voice communication.

Issacs teaches establishing voice communication (col 8, lines 16-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to enhance user experience. By utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

As to claim 11, Issacs teaches wherein the request is from the sender (col 8, lines 16-31).

As to claim 12, Issac teaches wherein the request is from the recipient (col 6, lines 15-21 and col 7, lines 44-67).

As to claim 13, Barness teaches the method of claim 10 further comprising authenticating request (0033, 0036).

As to claim 14, Barness teaches the method of claim 13 wherein authenticating the request comprises identifying a screen name associated with at least one of the sender and the recipient (0035).

As to claim 15, Barness teaches the method of claim 13, wherein authenticating the request comprises identifying an IP address associated with at least one of the sender and the recipient (0029, 0035)

As to claim 21, Barness teaches a communications apparatus comprising and instant message host configured to:

establishing a text instant messaging communication session between a sender and a recipient (0007, 0050, an instant messaging session is established via an instant message server);

facilitating a text instant message to be sent from the sender to the recipient during the session, the text instant message including message text inputted by the sender (0050, an instant message sent by a user is retrieved by the instant messaging server and displayed on the recipient's screen);

enabling presentation of a first text instant messaging graphical user interface to the recipient that includes the display of the message text, the presentation of the text instant message graphical user interface being conditioned on communication of the text instant message between the sender and the recipient (0050, the recipient is alerted to an incoming instant message by a pop-up window displaying the message)

However, Barness does not explicitly indicate that the graphical user interface includes an icon such that by enabling manipulation by the recipient of the icon, voice communication is invoked between the sender and the recipient through the instant messaging host.

Issacs teaches a system in which text instant messages and sound instant messages are exchanged between users (col 4, lines 14-17). Issacs further teaches enabling manipulation by the recipient of an icon to invoke voice communication between the sender and the recipient through the instant messaging host (col 6, lines 15-21 and col 7, lines 44-67, users may communicate with one another by sending voice instant messages. For example, a user may want to terminate a session with Bonnie and sends here a voice instant message saying "BYE" by selecting the "BYE" icon).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to make the system more efficient and enhance user experience. By using dedicated icons to send simple messages, users can quickly contact each other and make arrangements in a personal manner (col 9, lines 47-56). By utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

However Barness-Issacs do not teach that it is based on voice communication capabilities of the recipient. Salesky teaches a conferencing system in which various parameters are monitored and the system is reconfigured dynamically and automatically taking advantage of the software and hardware capabilities of the conferees/participants, including but not limited to voice communication capabilities (abstract, 0097, 0122).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Salesky into those of Barness-Issacs to make the system more robust. By allowing the system to dynamically adjust to the user's capabilities, presence



awareness and user responsiveness is greatly improved and efficient communication is facilitated.

As to claim 22, Barness teaches a non-transitory computer readable medium storing a program comprising instructions for:

establishing a text instant messaging communication session between a sender and a recipient through an instant messaging host (0007, 0050, an instant messaging session is established via an instant message server);

facilitating a text instant message to be sent from the sender to the recipient during the session, the text instant message including message text inputted by the sender (0050, an instant message sent by a user is retrieved by the instant messaging server and displayed on the recipient's screen);

enabling presentation of a first text instant messaging graphical user interface to the recipient that includes the display of the message text, the presentation of the text instant message graphical user interface being conditioned on communication of the text instant message between the sender and the recipient (0050, the recipient is alerted to an incoming instant message by a pop-up window displaying the message)

However, Barness does not explicitly indicate that the graphical user interface includes an icon such that by enabling manipulation by the recipient of the icon, voice communication is invoked between the sender and the recipient through the instant messaging host.

Issacs teaches a system in which text instant messages and sound instant messages are exchanged between users (col 4, lines 14-17). Issacs further teaches enabling manipulation by the recipient of an icon to invoke voice communication between the sender and the recipient

through the instant messaging host (col 6, lines 15-21 and col 7, lines 44-67, users may communicate with one another by sending voice instant messages. For example, a user may want to terminate a session with Bonnie and sends here a voice instant message saying "BYE" by selecting the "BYE" icon).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to make the system more efficient and enhance user experience. By using dedicated icons to send simple messages, users can quickly contact each other and make arrangements in a personal manner (col 9, lines 47-56). By utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

However Barness-Issacs do not teach that it is based on voice communication capabilities of the recipient. Salesky teaches a conferencing system in which various parameters are monitored and the system is reconfigured dynamically and automatically taking advantage of the software and hardware capabilities of the conferees/participants, including but not limited to voice communication capabilities (abstract, 0097, 0122).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Salesky into those of Barness-Issacs to make the system more robust. By allowing the system to dynamically adjust to the user's capabilities, presence awareness and user responsiveness is greatly improved and efficient communication is facilitated.

As to claim 23, Barness teaches the non-transitory computer-readable medium of claim 22 wherein the non-transitory computer-readable medium is provided comprises a disc (0037, 0039).

As to claim 24, Barness teaches the non-transitory computer-readable medium of claim 22 wherein the non-transitory computer-readable medium is provided as part of a client device (0040, 0041)

As to claim 25, Barness teaches the computer program of claim 22 wherein the non-transitory computer-readable medium is provided as part of a host device (0035).

As to claim 37, Barness teaches the method of claim 1 wherein the communications are invoked responsive to receiving a text instant message, however does not explicitly indicate wherein the communication is voice communication.

Issacs teaches establishing voice communication by way of icon (col 8, lines 16-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to enhance user experience. By utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

As to claim 38, Barness teaches the apparatus of claim 21, wherein the instant messaging host is configured to enable communication responsive to a text message being received. However, Barness does not explicitly indicate that the communication is voice communication.

Issacs teaches establishing voice communication (col 8, lines 16-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to enhance user experience. By

utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

As to claim 39, Barness teaches the computer program of claim 22, wherein the instructions for communications are invoked responsive to receiving a text instant message, however does not explicitly indicate wherein the communication is voice communication.

Issacs teaches establishing voice communication (col 8, lines 16-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to enhance user experience. By utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

As to claim 41, Barness teaches the communications method of claim 1, wherein the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message comprises not presenting the first text instant messaging graphical user interface if the text instant message is not received by the recipient (0050).

As to claim 42, Barness teaches the communications apparatus of claim 21, wherein the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message comprises not presenting the first text instant messaging graphical user interface if the text instant message is not received by the recipient (0050).

As to claim 43, Barness teaches the non-transitory computer readable medium of claim 1, wherein the presentation of the first text instant messaging graphical user interface being

conditioned on communication of the text instant message comprises not presenting the first text instant messaging graphical user interface if the text instant message is not received by the recipient (0050).

As to claim 44, it contains similar limitations as the above-rejected claims and is thus rejected under similar rationale. It should be understood that although the presentation of the GUI is based on voice capabilities, the rationale to combine the arts is the same.

***Allowable Subject Matter***

4. Claims 9 and 16-20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

5. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Tang et al, US 6,731,308, Patented May 4, 2004

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASAD M. NAWAZ whose telephone number is (571)272-3988. The examiner can normally be reached on M-F 8-4:30.

7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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/Asad M Nawaz/  
Primary Examiner, Art Unit 2455